

REMARKS

This application has been carefully reviewed in light of the Office Action dated January 26, 2005. Claims 1 and 3-7 remain pending in this application. Claims 1, 6, and 7 are the independent claims. Favorable reconsideration is respectfully requested.

On the merits, the Office Action rejected Claim 7 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully believe the amendment to Claim 7 adequately responds to the § 112, second paragraph rejection and requests its withdrawal.

Further on the merits, the Office Action rejected Claims 1 and 5-7 under 35 U.S.C. § 102(e) as being anticipated by Nakamura et al., (U.S. Patent No. 6,529,714; hereinafter "Nakamura"). The Office Action also rejected Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of Fuchs (U.S. Patent No. 3,870,184; hereinafter "Fuchs"). The Office Action also rejected Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Nakamura in view of Savovic et al. (U.S. Patent No. 5,260,146; hereinafter "Savovic"). Applicants respectfully submit the pending Claims are allowable for at least the following reasons:

Nakamura fails to recite or suggest a lever element being arranged to bend a material of lower hardness, external to the portable electronic apparatus, by way of a leverage effect. Rather, Nakamura's lid merely secures a battery internal to the portable electronic apparatus. The Office Action responds to this argument by claiming that Nakamura's lid (lever element) inherently bends a material of lower hardness external to the portable apparatus by way of a leverage effect. Applicants respectfully note that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art (as opposed to the examiner's expectation). Mere possibilities or even probabilities are not enough; necessity recognized by those of skill in the art is required.<sup>1</sup> The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or be present in the

<sup>1</sup> The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v.

Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)(emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgig v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

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prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Office Action must provide objective evidence or cogent technical reasoning to support a contention of inherency.<sup>2</sup>

Simply because, as the Office Action alleges, Nakamura inherently bends a material of lower hardness external to the portable electronic apparatus by way of a leverage effect, it is not satisfactory to support an inherency argument. The Office

<sup>2</sup> "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Action fails to provide any objective evidence or basis for this argument.

Additionally, Nakamura merely recites that lid 3 is attached to telephone housing 2 to cover battery storing recess 2A. (Col. 2, lines 59-65) Lid 3 is nowhere recited or suggested in Nakamura as having a lever element as a part of the housing that is arranged to bend a material of lower hardness, external to the portable electronic apparatus, by way of a leverage effect. Even assuming arguendo that Nakamura's lid 3 is somehow a lever, it fails to possess any part of the lid that can bend a material of lower hardness external to the device. Applicants believe Claim 1 to be patentable over Nakamura for at least these reasons and Applicants respectfully traverse the § 102 rejection of Claim 1 for at least the above reasons.

Claims 6 and 9 recite a mobile telephone and a mobile telephone housing, respectively, substantially corresponding to the portable electronic apparatus of Claim 1 and are believed patentable for at least the same reasons.

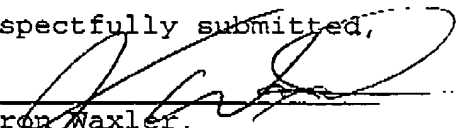
Claims 3-5 depend from one or another of the independent Claims recited above and are believed patentable for at least the same reasons. In addition, Applicants respectfully believe Claims 3-5 to be independently patentable and request separate consideration of each claim. Further, Applicants respectfully

believe the § 103 rejections of Claims 3 and 4 to be moot in light of the above remarks and request their withdrawal.

In view of the foregoing amendments and remarks, Applicants respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached by telephone at the number given below.

Respectfully submitted,

By   
Aaron Waxler,  
Reg. 48,027  
(914) 333-9608  
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